

REMARKS

Applicant acknowledges with appreciation the examiner's approval of the proposed drawing correction submitted with Amendment "A" filed on June 3, 2002.

The rejection of Claims 1-20 under U.S.C. § 112(2) has been withdrawn.

The rejection under U.S.C. § 103(a) over Craig, U.S. Patent No. 5,690,079, has been withdrawn.

The finality of the rejection under U.S.C. § 103(a) over Nagy has been withdrawn.

Claims 1-20 remain pending in the application.

Applicant respectfully requests reconsideration and examination of Claims 1-20 in view of the arguments below.

By way of this response, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the examiner telephone Thomas F. Lebens at (805-781-2865) so that such issues may be resolved as expeditiously as possible.

Response to the rejection under 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagy, U.S. Patent No. 3,729,158 (Nagy). Applicant traverses the rejection as follows.

The rejection fails to arrive at the claimed invention

Regarding the rejection of Claims 1, 4, 7, 11-14, 18 and 19, the rejection errs on page 2 in alleging that Nagy discloses a resilient vertical leg (24) that "inherently has a force constant which may be selected to produce some displacement of the distal portion when subjected to a shock

without causing failure of the resilient member (24) beyond its inherent elastic limit." Specifically, the rejection alleges a limitation that does not arrive at the claimed invention and relies on an argument that the Nagy meets the alleged limitation to support the rejection. Claims 1, 4, 7, 11-14, 18 and 19 do not recite "without causing failure of the resilient member (24) beyond its inherent elastic limit" as alleged by the rejection. The failure of the resilient member is not at issue in Claims 1, 4, 7, 11-14, 18 and 19. To the contrary, the limitation at issue in Claims 1, 4, 7, 11-14, 18 and 19 is "the force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet". The limitation alleged by the rejection clearly fails to arrive at the claimed invention. Because the rejection fails to arrive at the claimed invention, the rejection is insufficient to show obviousness over Nagy under 35 U.S.C. § 103(a).

The claimed force constant is not inherent in Nagy

The rejection further errs in alleging on page 2 that the claimed force constant is inherent in Nagy. Specifically, the rejection argues that the vertical leg (24) "inherently has a force constant which may be selected ...". However, MPEP § 2112 (2100-51) states the following:

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 15321, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)..."

Because the rejection relies on the argument that the claimed force constant may be selected to arrive at the claimed invention, the rejection clearly errs according to MPEP §

2112, and is therefore insufficient to establish inherency of the claimed force constant. Further, MPEP § 2112 (2100-51) continues as follows:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient'. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999)..."

Nagy does not address the issue of acceleration of the paintbrush or of mechanical shock as disclosed by Applicant, therefore the claimed force constant does not necessarily flow from Nagy as required by MPEP § 2112 to support a rejection based on inherency.

Still further, MPEP § 2112 (2100-52) states the following:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter 1990) (emphasis in original)..."

The Examiner has provided neither a basis in fact nor the technical reasoning to reasonably support the determination that the claimed force constant necessarily flows from the teachings of the applied prior art.

Because the rejection fails to arrive at the claimed subject matter, and because the rejection fails to meet the

burden of proof required by MPEP § 2112 to support a rejection based on inherency, Claims 1, 4, 7, 11-14, 18 and 19 are not obvious over *Nagy* under 35 U.S.C. § 103.

The invention as a whole is not taught or suggested in *Nagy*

The rejection further errs on page 4 in dismissing the selection of the claimed force constant as a "user preference or a design choice" without considering the claimed invention as a whole. Specifically, MPEP § 2141.02 (2100-118) states the following:

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)..."

Nagy does not consider acceleration of the paintbrush as a factor in avoiding slipping of the paintbrush off the magnet, therefore there is no teaching or suggestion in *Nagy* that would motivate one of ordinary skill to arrive at the claimed invention as a whole without benefit of impermissible hindsight gained from Applicant's disclosure.

The rejection further errs in failing to consider the problem discovered in Applicant's disclosure.

Specifically, MPEP § 2141.02 (2100-119) states the following:

"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103. *In re Sponnoble*, 405

F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969)..."

Applicant's disclosure reveals the source of the problem of a paintbrush slipping from a magnet due to acceleration of the paintbrush. See, for example, page 3, lines 19-20 of the specification, which state: "His [Applicant's] main insight was in recognizing the need to mechanically isolate the paintbrush and magnet from the paint can." *Nagy*, however, does not recognize or address the need to mechanically isolate the paintbrush and magnet from the paint can. Because the rejection fails to consider Applicant's discovery of the problem, the rejection fails to meet the burden required by MPEP § 2141.02 to support a rejection under 35 U.S.C. § 103.

Regarding the rejection of Claims 2, 5, 8 and 15, the rejection errs on page 3 in alleging that *Nagy*'s vertical leg (24) arrives at the claimed invention because it "inherently acts as a spring whenever a force is applied perpendicularly to it". As may readily be appreciated from FIGS. 1 and 2 in *Nagy*, the force applied to the vertical leg (24) when the paint can (6) is picked up and set down is substantially parallel, not perpendicular as alleged by the rejection, to the vertical leg (24). Because the conditions presumed by the rejection are contrary to those shown in *Nagy*, Claims 2, 5, 8 and 15 are non-obvious over *Nagy* under 35 U.S.C. § 103.

Further, *Nagy*'s vertical leg (24) illustrated in FIGS. 1 and 2 is a rigid bracket typical of the prior art recognized by Applicant on page 7, lines 17-23 of the specification:

"By way of contrast, if the spring were replaced by a rigid bracket such as those used in the prior art, the force constant K could be 3 lb. per hundredth of an inch (equals 3600 lb./ft.). It is seen that, in this example,

the use of a spring instead of a rigid bracket reduces the maximum acceleration of the brush by a factor of 10, from 7.5 'g' to 0.75 'g', and the maximum downward force of the paintbrush is reduced from 4.25 pounds to 0.875 pound. This reduction clearly makes the difference between the paintbrush remaining on the magnet and its being jarred off the magnet and falling into the paint."

There is no teaching or suggestion in *Nagy* that a force constant inherent in the vertical leg (24) is capable of reducing the maximum acceleration of the brush by a factor of 10 so that the paintbrush does not slide off the magnet when subjected to a mechanical shock, therefore Claims 2, 5, 8 and 15 are non-obvious over *Nagy* under 35 U.S.C. § 103.

Because Claims 3, 6, 9 and 16 include all the limitations of Claim 1, Claims 3, 6, 9 and 16 are likewise non-obvious over *Nagy* under 35 U.S.C. § 103.

Regarding the rejection of Claims 10, 17 and 20, the rejection admits on page 3 that "*Nagy* fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75g." The rejection argues that "any number of resilient members ... could be selected..." Again, the rejection errs in relying on the allegation that the claimed force constant "could be" selected, but fails to show that the claimed force constant necessarily flows from *Nagy* as required by MPEP § 2112 to support a rejection under 35 U.S.C. § 103.

The rejection relies on impermissible hindsight

The rejection of Claims 10, 17 and 20 further errs on page 3 in alleging that "there appears to be no unexpected result stemming from the 0.75g recitation". The rejection fails to present any evidence why the result that the

paintbrush does not slide off the magnet would be expected for any reason other than the obvious benefit of knowledge gleaned solely from Applicant's disclosure: "This reduction [in acceleration] clearly makes the difference between the paintbrush remaining on the magnet and its being jarred off the magnet and falling into the paint." No such result is taught or suggested in Nagy, therefore it is clearly apparent that the rejection appreciates the significance of the 0.75g limitation from knowledge gleaned solely from Applicant's disclosure. Because the rejection apparently relies on knowledge gleaned solely from Applicant's disclosure, the rejection relies on impermissible hindsight to arrive at the claimed invention and is therefore insufficient according to MPEP § 2145 (X)(A) (2100-152) to support a rejection under 35 U.S.C. § 103.

Counter response to arguments

The rejection further errs on page 4 in alleging that "whether or not the force constant was selected to produce a displacement of the distal portion when subjected to a mechanical shock would be a user preference or a design choice." Again, the rejection fails to consider the claimed invention as a whole as required by MPEP § 2141.02 (2100-118). The rejection fails to show that Nagy teaches or suggests the claimed invention as a whole. Specifically, Nagy does not teach or suggest a force constant selected so that the paintbrush does not slide off the magnet when subjected to a mechanical shock.

Further, the rejection fails to consider all the limitations in the claims, for example, "so that the paintbrush does not slide off the magnet" recited in Claims 1 and 13. The rejection incorrectly concludes that the claimed force constant and the claimed displacement are inherent in

the flat-faced strap metal disclosed in *Nagy*. The claimed force constant selected to produce a displacement of the distal end when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet is not taught or suggested in *Nagy*. Because the rejection fails to consider all the claim limitations, the rejection fails to arrive at the claimed invention. Because the rejection fails to arrive at the claimed invention, Claims 1-20 are non-obvious over *Nagy* under 35 U.S.C. § 103.

The rejection further errs on page 4 in alleging that *Nagy* teaches the claimed paintbrush holder of Claim 14 wherein the resilient member, the magnet holder, and at least a portion of the clamp constitute a single molded structure. The rejection offered no contest to the facts presented in Applicant's argument in Amendment "B" filed on September 16, 2002:

"*Nagy* explains in column 2, lines 60-67 and column 3, lines 1-5, the magnet (48) is held on the upper portion of the leg (24) by a washer (40) and two rectangular cleats (42) and (44). Because the structure of the magnet holder disclosed in *Nagy* includes the washer (40) and two separate rectangular cleats (42) and (44) that are fastened to the vertical leg (24) to make the magnet holder, the magnet holder disclosed in *Nagy* clearly does not constitute a single molded structure as alleged by the rejection. The rejection therefore errs in reading the limitation of 'a single molded structure' recited in Claim 14 into *Nagy* even though *Nagy* clearly does not teach a resilient member, a magnet holder, and at least a portion of a clamp constituting a single molded structure."

The rejection incorrectly argues that simply because

Nagy's magnet holder is held together, it must be a single molded structure. The structural differences between a single molded structure and an assembly of parts held together by fasteners or other means is plainly manifest to one of ordinary skill in the art. Nagy does not teach or suggest the alternative of replacing his assembly of parts with a single molded structure. Because the argument offered by the rejection that an assembly of parts is equivalent to the claimed single molded structure is clearly inconsistent with the ordinary meaning of "a single molded structure" as it is understood in the art, the rejection fails to arrive at the claimed invention. Because the rejection fails to arrive at the claimed invention, Claim 14 is non-obvious over Nagy under 35 U.S.C. § 103.

The rejection further errs on page 4 in relying on impermissible hindsight for motivation to select the claimed force constant of the resilient member to limit the acceleration of the paintbrush to 0.75 g. The rejection argues that hindsight reasoning is proper so long as it takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from Applicant's disclosure. However, the rejection fails to show where Nagy teaches or suggests selecting a force constant to limit the acceleration of a paintbrush to no more than 0.75 g. The rejection also fails to explain how one of ordinary skill in the art motivated by avoiding compromising the integrity of the paintbrush holder or by meeting a user's design preferences or by the specific dimensions of an object attached to the resilient member would be led in view of Nagy to arrive at the claimed invention of limiting the acceleration of a paintbrush to no more than 0.75 g so that

the paintbrush does not slide off the magnet. Because no motivation is shown in *Nagy* to make the modification proposed by the rejection, and because the modification proposed by the rejection apparently relies on knowledge gleaned solely from Applicant's disclosure, the rejection apparently relies on impermissible hindsight to arrive at the claimed invention and is therefore insufficient according to MPEP § 2145

(X) (A) (2100-152) to support a rejection under 35 U.S.C. § 103.

The rejection further errs on page 5 in alleging that because the claimed force constant may be selected, it is considered unpatentable. As explained above, the rejection fails to meet the criteria required by MPEP § 2112 to support a rejection under 35 U.S.C. § 103.

Conclusion

Because the rejection fails to arrive at the claimed invention, because the claimed force constant is not inherent in *Nagy*, because the invention as a whole is not taught or suggested in *Nagy*, and because the rejection relies on impermissible hindsight, Claims 1-20 are non-obvious over *Nagy* under 35 U.S.C. § 103.

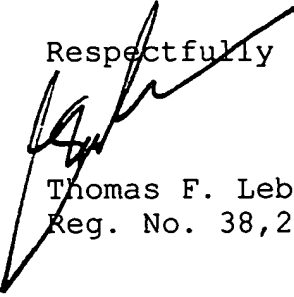
No additional fee is required for this amendment.

Amendment "C"
Application No. 09/751,609
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In view of the above arguments, Applicant submits that Claims 1-20 are in condition for allowance, and prompt and favorable action is earnestly solicited.

Respectfully submitted,



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